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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,172	10/04/2000	Helmut Schreiner	1438-30	7232

7590 07/08/2003

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EXAMINER	
TREMBLAY, MARK STEPHEN	
ART UNIT	PAPER NUMBER
2827	

DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/581,172	SCHREINER	
	Examiner	Art Unit	
	Mark Tremblay	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-36 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-36 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 10, 12-17, 32 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent #6,025,054 to Tiffany, III ("Tiffany" hereinafter). Tiffany teaches a label (a smart card is inherently a "label" for people, cars, semiconductor wafer carriers, luggage, etc. etc.) comprising at least one electronic component, characterized in that the electronic component is cast in synthetic material (polyurethanes made by condensation reactions of isocyanate and a polyol; see column 6, lines 39-41).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 11, 18-20, are rejected under 35 U.S.C. § 103 as being unpatentable over Tiffany.

Re claims 18-20, Official Notice is taken that polished silicon molds are old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use polished silicon molds for the molding process of Tiffany, in order to produce a smooth surface, and avoid sticking, as is well known in the art. See references cited by Examiner but not relied upon.

Re claim 11, it is well known to print on the synthetic material, or provide it with color for aesthetic purposes. Also, the claimed color has not been described or claimed to have any significant utility.

Claims 2-7, 9, 20-25, and 33-36 are rejected under 35 U.S.C. § 103 as being unpatentable over Tiffany in view of U.S. Patent #5,469,363 to Saliga et al, further in view of U.S. Patent #5,153,842 to Dlugos, Sr. et al. ("Dlugos" hereinafter). Tiffany teaches the features of the invention but does not teach that the label may be adhesively affixed to an item. Dlugos teaches that a label may be adhesively affixed to an item. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to affix the label with an adhesive to an item, because such a label can provide useful information about the item in electronic form, as taught by Dlugos. The combined teachings do not suggest that the label have an adhesive backing. Saliga teaches that the label may have an adhesive backing. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the label directly with an adhesive backing because this would allow the label to be directly affixed to the item, as taught by Saliga. The combined teachings suggest that there will be situations in which a permanent label is desirable, and times when a removable label is desirable. Known adhesives can accommodate both situations.

Re claims 5-6, Official Notice is taken that adhesive, siliconized foils are notoriously old and well known in the label art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. Most children in the US are familiar with so called "ez-peel" labels. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide siliconized ez-peel foils as a backing for the adhesive labels of the combined teachings because ez-peel technology allows a label with an adhesive backing to be rendered available for affixing at the desired time of use, not before, when the labels are not ready to be used.

Re claims 20-25, support materials are well known in the art, and known to have printing thereon.

Claims 2, 7-9, and 33-36 are rejected under 35 U.S.C. § 103 as being unpatentable over Tiffany in view of U.S. Patent #5,478,991 to Watanabe et al. ("Watanabe" hereinafter). Tiffany teaches the features of the invention but does not teach that the label may be mechanically affixed to an item with a ribbon. Watanabe teaches that a label may be mechanically affixed to an item with a ribbon. It would have been obvious at the time the invention was made to a person having

ordinary skill in the art to affix the label with a ribbon to an item, because such a label can provide useful information about the item in electronic form, as taught by Watanabe, and such an arrangement avoids an adhesive problem when items such as luggage may be damaged by a strong adhesive, may lose a label attached by a weak adhesive, and provide points for convenient mechanical attachment of a label, e.g. by a ribbon.

Claims 26-32, are rejected under 35 U.S.C. § 103 as being unpatentable over Tiffany in view of U.S. Patent #5,777,903 to Poiosenka et al. ("Piosenka" hereinafter). Tiffany teaches the features of the invention but does not teach that the label may include a display. Piosenka teaches that a smart card may contain a display. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the smart card of Tiffany to include a display as taught by Piosenka et al. in order that the tag may display the contents of it's memory, as taught by Piosenka.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent #6,146,923 to Ohmi et al. and U.S. Patent #4,784,818 to Wakai et al. are cited for showing known silicon molds.

U. S. Patent #5,686,382 and U. S. Patent #6,048,619 are cited for showing other cards using a polyurethane resin.

U. S. Patent #6,019,394 U. S. Patent #5,557,096 and U. S. Patent #4,916,296 are cited for showing other embodiments of electronic labels.

Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

MARK TREMBLAY
PRIMARY EXAMINER

June 29, 2003